

***United States Court of Appeals
for the Second Circuit***



APPENDIX

ORIGINAL **74-1774** ^B_{1/5}

United States Court of Appeals
For the Second Circuit

73 Civ. 4865

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff-Appellant,

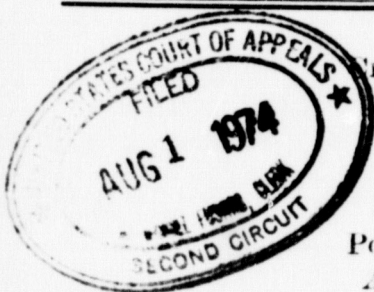
against

HONORA JEWELRY CO., INC., JERRY J. GROSS-
BARDT and STANLEY SCHECHTER,

Defendants-Appellees.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

JOINT APPENDIX



CHARLES SONNENREICH,
Attorney for Plaintiff-Appellant,
500 Fifth Avenue,
New York, New York 10036.
354-2910

POLLACK & SINGER,
Attorneys for Defendants-Appellees.
61 Broadway,
New York, New York 10006.
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Docket Entries

- Nov. 13-73 Filed complaint & issued summons.
- Dec. 5-73 Filed Defts' first requests to produce.
- Dec. 6-73 Filed Answer to complaint.
- Dec. 6-73 Filed deft. interrogatories to pltf. (1st set)
- Dec. 6-73 Filed defts. notice of deposition of pltf.
- Nov. 29-73 Filed summons with marshals return served:
Honora Jewelry by J. J. Grossbardt, Jerry J. Grossbardt, P/S and Stanley Schecter by J. S. Grossbardt
(all 11-15-73.)
- Dec. 19-73 Filed stip. & order adjourning examination of
pltff.—& production of documents and time for pltff.
to answer interrogs. to 1-31-74—Brieant, J.
- Jan. 28-74 Filed pltffs. answers to defts. interrogs.
- Jan. 31-74 Filed stip. & order adjourning deposition of
Herbert Rosenthal Jewelry Corp. to 2-27-74—Brieant,
J.
- Feb. 6-74 Filed pltff's answer to deft's request to produce
- Feb. 15-74 Pre-trial conference held
- Apr. 4-74 Filed pltffs. affdvt. & notice of motion for
summary judgment. Ret. 4-22-74.
- Apr. 4-74 Filed pltffs. memo of law in support of motion.
- Apr. 17-74 Filed deft's affdvt. in opposition to pltffs.
motion for summary judgment.
- Apr. 17-74 Filed deft's. memo in opposition to motion
for summary judgment.
- Apr. 18-74 Filed deposition of pltff. Herbert Rosenthal
Jewelry Corp.
- Apr. 23-74 Filed pltfs. reply affdvt. to defts. opposition
to motion.

Docket Entries

- Apr. 23-74 Filed pltfs. reply memo.
- Apr. 23-74 Filed deposition of defts. Honora Jewelry Co.
- Apr. 29-74 Filed reply affdvt of Herbert Rosenthal.
- May 1-74 Filed deft's supplemental affdvt.
- May 1-74 Filed by pltff. affdvt. of Charles Sonnenreich, in answer to supplemental affdvt.
- May 23-74 Filed defts. affdvt. in opposition to motion for summary judgment.
- May 23-74 Filed memorandum & order—pltff's motions for summary judgment and for a preliminary injunction are denied. Summary judgment is granted as to defts. and the complaint is dismissed—The Clerk shall enter judgment pursuant to Rule 58(1)—that all relief shall be denied—So ordered—Brieant, J.
- June 4-74 Filed Judgment that defts. have judgment against pltff. dismissing the complaint. Judgment entered—Clerk—mailed notice ent. 6-5-74
- June 5-74 Filed notice of appeal by plaintiff from the order dated May 23-74, denying plaintiff's motion for a preliminary injunction and summary judgment against defts and the order and judgment filed June 4, granting summary judgment to the defendants and dismissing complaint. m/n to defts.
- June 10-74 Order to show cause by pltff for preliminary injunction pending appeal, stay denied.
- June 11-74 Letter from Charles Sonnenreich to Judge Brieant dated June 10, 1974.
- June 11-74 Letter from Pollack & Singer dated June 10, 1974 to Judge Brieant.
- June 11-74 Memo from Judge Brieant adhering to original decision.

Complaint**UNITED STATES DISTRICT COURT****SOUTHERN DISTRICT OF NEW YORK**

[SAME TITLE]

Plaintiff, by its attorney, complaining of the defendants, alleges as follows:

1. Plaintiff is a New York corporation duly organized under the Laws of the State of New York, with its principal place of business in the Borough of Manhattan, City, County and State of New York.

2. Upon information and belief, the corporate defendant Honora Jewelry Co., Inc., is a New York corporation duly organized under the Laws of the State of New York, with its principal place of business in the Borough of Manhattan, City, County and State of New York.

3. Upon information and belief, the defendants, Jerry J. Grossbardt and Stanley Schecter are citizens and inhabitants of the State of New York and are engaged in business in the Southern District of New York at 42 West 48th Street, New York, New York, under the trade name and style of Honora Jewelry Co., Inc., and are the conscious and dominant driving force responsible for the hereinafter alleged wrongful acts of the several defendants.

4. This cause of action arises under the Copyright Laws of the United States (Title 17, U.S.C. 101, 112, 116) and is brought to redress the infringement of copyrighted artistic jewelry. Jurisdiction is conferred on this Court by Title 28, U.S.C. Section 1338.

Complaint

5. Plaintiff is a designer, manufacturer and seller of fine jewelry incorporating precious metals, precious and semi-precious stones. Plaintiff's jewelry is of high quality and largely innovative design and is widely accepted by the purchasing public as highly desirable jewelry to own and wear.

6. Prior to April 13th, 1967, plaintiff designed a jeweled turtle pin of original and distinctive design made of gold and jewels. This pin is wholly original with the plaintiff and is copyrightable subject matter under the Laws of the United States. This pin was published on April 13, 1967, a photograph of the pin is attached as Exhibit I.

7. Between April 13, 1967 and the date hereof, plaintiff complied in all respects with the Act of July 30, 1947 and all other laws governing copyright and secured the exclusive rights and privileges in and to copyright of said jeweled turtle and received from the Register of Copyrights, Certificate of Registration No. Gp 56652, covering plaintiff's aforesaid design, a copy of which is annexed as Exhibit II.

8. Reproductions of plaintiff's jeweled turtle have been sold by plaintiff since April 13, 1967, and all reproductions made by plaintiff or under its authority have been manufactured or sold in strict conformity with the provisions of the Act of July 30, 1947, Title 17, United States Code, and all other laws governing copyright.

9. Plaintiff at all times herein has been and still is the sole proprietor of all right, title and interest in and to the copyright in said jeweled turtle.

Complaint

10. After April 13, 1967, the defendants Jerry J. Grossbardt and Stanley Schechter, individually and as co-partners trading as Honora Jewelry Co., infringed upon plaintiff's copyright by manufacturing and selling a jeweled turtle pin which they admittedly copied from plaintiff's pin.

11. A suit for infringement of plaintiff's copyright by the said individual defendants here, was brought by plaintiff in this Court under Civil Action No. 68 Civ. 4154 and resulted first, in the granting by Hon. Charles M. Metzner of this Court of a preliminary injunction restraining the individual defendants here from infringing plaintiff's copyright and then the affirmance by the Court of Appeals of this Circuit of said order. Thereafter the individual defendants here consented to the entry of a final decree permanently restraining them, their agents, servants and employees, and all persons, firms and corporations acting by or in concert with or under them, their control, direction or license, whether directly or indirectly, from infringing plaintiff's copyright.

12. That thereafter and since the entry of said final decree the individual defendants herein acting through the corporate defendant which they control commenced to manufacture and sell turtle jeweled pins simulating in design the design of plaintiff's copyrighted turtle pin.

13. Defendants' infringement of plaintiff's copyright was and is wilful, wanton and in utter disregard of plaintiff's rights and said infringement is continuing to the present day all to the plaintiff's irreparable damage, loss and injury.

Complaint

14. Defendants' infringement of plaintiff's copyright caused plaintiff monetary damage in an amount thus far not determined, but in excess of Ten Thousand Dollars (\$10,000.).

WHEREFORE, plaintiff demands:

1. A preliminary and permanent injunction restraining, enjoining and prohibiting the individual and corporate defendants, their servants, agents, employees and representatives and each of them and those persons in active concert and participation with them from infringing plaintiff's copyright.

2. That defendants be required, by order of the Court, to deliver up for destruction all jeweled turtle pins infringing plaintiff's copyright, and all molds and mechanical parts used in the manufacture of the same.

3. An accounting of profits and damages resulting from defendants' activities as aforesaid including reasonable counsel fees and an assessment of costs.

4. Such other and further relief as may be deemed just and proper in the premises.

CHARLES SONNENREICH

Attorney for Plaintiff

500 Fifth Avenue

New York, New York 10036

Tel 354 2910

Answer

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

Defendants, by their attorneys, Pollack & Singer, deny each and every allegation of the Complaint except as expressly admitted or otherwise specifically denied.

*Paragraph of
Complaint*

Specific Response

- | | |
|---------|--|
| 1 and 6 | Deny knowledge or information sufficient to form a belief as to the truth of this allegation. |
| 2 | Admit. |
| 3 | Admit that defendants Jerry J. Grossbardt and Stanley Schechter are citizens and inhabitants of the State of New York and officers and directors of the defendant Honora Jewelry Co., Inc. |
| 12 | Specifically deny that any of the defendants copied a jeweled turtle pin from any jeweled turtle pin made by the plaintiff since the entry of said final decree. |

First Affirmative Defense

2. The Complaint fails to state a claim upon which relief can be granted.

Answer

Second Affirmative Defense

3. By virtue of the failure of the plaintiff to comply with the notice requirements of Section 19 of the Copyright Act (Title 17, U.S.C. §19), the plaintiff never acquired, or, alternatively, has abandoned, a valid copyright in the jeweled turtle pin alleged to have been made by it.

Wherefore, the defendants demand dismissal of the complaint herein, with the costs and disbursements of this action, including reasonable counsel fees.

Dated: New York, New York
December 5, 1973

POLLACK & SINGER

By DANIEL A. POLLACK
(A Member of the Firm)
Attorneys for Defendants
61 Broadway
New York, New York 10006
(212) 952-0330

To:

CHARLES SONNENREICH, Esq.
Attorney for Plaintiff
500 Fifth Avenue
New York, New York 10036

Plaintiff's Motion for Summary Judgment**UNITED STATES DISTRICT COURT****SOUTHERN DISTRICT OF NEW YORK**

[SAME TITLE]

SIRS:

PLEASE TAKE NOTICE, that upon the affidavits of Herbert Rosenthal and Charles Sonnenreich sworn to April 1, 1974, the pleadings and proceedings had herein, the exhibits referred to and attached hereto, the deposition of Jerry J. Grossbardt, the stipulation of March 15, 1974 as well as all of the pleadings and proceedings had in Civil 64 Civ. 4154 in this Court, the undersigned will move this Court at a Motion Term thereof, on the 22nd day of April, 1974, to be held in Room 906, United States Courthouse, Foley Square, New York, N. Y. at 9:30 A.M. for an order granting summary judgment in favor of the plaintiff striking out the answer of the defendants and pending the determination of the motion granting plaintiff a preliminary injunction restraining the defendants from infringing plaintiff's copyright and for such other and further relief as may be proper.

Defendants are required to produce upon the argument of this motion, the turtle pins manufactured by them, styles 3167D; 3167E; 3167S; 3167R; 3291R (Pl's Ex. 5).

April 2, 1974

Yours etc.

CHARLES SONNENREICH**Attorney for Plaintiff****500 Fifth Avenue****New York, N. Y. 10036****354-2910****To:****POLLACK & SINGER, ESQS.****Attorneys for Defendants****61 Broadway****New York, N. Y.**

Affidavit of Herbert Rosenthal in Support of Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York
County of New York—ss.:

HERBERT ROSENTHAL, being duly sworn deposes and says, I am the Chairman of the Board of Directors of the plaintiff and before that and since the incorporation of the plaintiff was the President thereof. I am fully familiar with all the facts and prior proceedings had herein.

Since 1945 the plaintiff and its predecessor have been engaged in the manufacture and sale of precious jewelry sold to the finest stores in the United States including Cartier, Tiffany, Nieman Marcus and Leykin et Cie of Los Angeles, Cal.

Prior to April 13th, 1967, plaintiff had designed for it a jeweled turtle pin made of 14 karat gold, the back of which was ornated with a cluster of precious gems including diamonds, rubies, emeralds and sapphires and combinations thereof. An application for Copyright Registration was filed with the Register of Copyrights and Copyright Certificate No. Gp56652 was issued to the plaintiff on December 4, 1967. Plaintiff at all times complied with the statute covering markings with the copyright notice. A copy of the registration is attached to the complaint and marked Exhibit I. An illustration of the turtle pin as filed with the Copyright Office is also attached to the complaint and marked Exhibit II. Plaintiff has sold hundreds of its

Affidavit of Herbert Rosenthal

turtle pins ranging from \$200 to \$1,000. each depending upon the gems used.

This is the third suit for copyright infringement brought by plaintiff against the individual defendants herein. The prior suits involved the copying of a jeweled bee pin (67 Civ. 4674) in which the defendants admitted copying one of plaintiff's pins, and another involving the same copyright of the turtle here, where the defendants also admitted copying plaintiff's turtle exactly. In the bee case Judge Palmieri found the copyright valid and infringed and the Court of Appeals affirmed the judgment below. In the prior turtle case, Judge Metzner granted plaintiff a preliminary injunction which was affirmed on appeal. Thereafter the defendants consented to a final decree permanently enjoining them from further infringements of plaintiff's copyright. A copy of the final decree in the prior turtle case is attached hereto.

In the prior turtle case the defendants claimed that plaintiff was not the owner of the copyright and that it had failed to properly mark its pins as prescribed by the Copyright Statute but both the lower Court and the Court of Appeals rejected these arguments. A photograph of the pins involved in the prior turtle suit (marked as Exhibit 2 there) and marked Exhibit 1 on the Rosenthal deposition is attached hereto.

Sometime towards the latter part of October or early November, 1973, your deponent received through the mail a catalog issued by Abercrombie & Fitch Co., which illustrated a jeweled turtle pin on page 11 thereof which appears to be closely similar in design to plaintiff's pin. The manufacturer was given as the corporate defendant herein. A pin was purchased from that store which has been marked Exhibit B on deponent's deposition of Feb-

Affidavit of Herbert Rosenthal

ruary 27th, 1973. One of plaintiff's pins marked Exhibit A will also be exhibited to the Court. An examination of defendants' pin discloses the same cluster of stones in the exact arrangement as found on the back of plaintiff's pin. A solid gold figure of a turtle with only slight differences in its body is used by defendants. The overall appearance of defendants' pin however, so closely resembles plaintiff's as to give the same impression to any average purchaser. Furthermore, defendant Grossbardt on his deposition admitted using the same stones as plaintiff as well as the same combination of stones. It is apparent to deponent as it should be to this Court that defendants sought to closely simulate plaintiff's pin in order to capitalize on its popularity and the extensive advertising by plaintiff. Defendants further admitted by stipulation dated March 15, 1974 herein, that its selling prices were far below plaintiff's selling prices, leaving your deponent to conclude that defendants used inferior gems and gold in order to undersell plaintiff.

Another thing which should be called to this Court's attention is the fact that defendants began to manufacture and sell its current turtle pins while the prior infringement suit was pending without disclosing this fact either to the Court or the plaintiff.

The continued sale by defendants of their pin can only harm plaintiff's business in this respect. The motion for judgment should be granted and defendants permanently enjoined from infringing plaintiff's copyright. An accounting of profits and damages should be directed as well as the allowance of reasonable attorneys fees.

HERBERT ROSENTHAL

(Sworn to by Herbert Rosenthal, April 1, 1974)

Plaintiff's Exhibit 1, Photograph of Turtle Pin

Included in Exhibit Volume.

**Plaintiff's Exhibit 4, Page 11 of Catalog Issued by
Abercrombie & Fitch Co.**

Included in Exhibit Volume.

Affidavit of Charles Sonnenreich in Support of Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York
County of New York—ss.:

CHARLES SONNENREICH being duly sworn deposes and says, I am the attorney for the plaintiff herein and was also plaintiff's attorney in 68 Civil 4154, brought in this Court against the individual defendants here, then co-partners trading as Honora Jewelry Co. The prior suit was for the infringement of the copyright covering the same jeweled turtle pin and resulted in the granting of a preliminary injunction which was affirmed on appeal.

In the prior suit the individual defendants admitted copying plaintiff's pin exactly using the same stones and

Affidavit of Charles Sonnenreich

combination of gems as plaintiff. A photograph of plaintiff's pins which defendants admitted copying was marked Exhibit 2 on the deposition of defendant Schechter, is now marked Exhibit 1 in this suit. After the affirmance by the Court of Appeals of Judge Metzner's order granting the preliminary injunction, the individual defendants entered into a consent decree dated June 14, 1971 making the injunction permanent.

It appears now that in 1971 the individual defendants incorporated and carried on the same business as the sole stockholders and directors of the defendant corporation. It also appears now that while the prior suit was pending, the individual defendants began to manufacture and sell the pins which are the subject of this suit. (Defendants' Ex. B and Plaintiff's Ex. 5.) The latter is a smaller version of Exhibit B. No mention was made to the plaintiff or the Court that defendants were making and selling the pins now before this Court.

After plaintiff became aware of the sale to Abercrombie & Fitch of the turtle pins, suit was brought against that firm by plaintiff. In spite of a letter of indemnity given Abercrombie & Fitch by defendants here, the former agreed to discontinue the exhibition and sale of the defendants' pins, and all were removed from sale. Attached hereto is a photostatic copy of the Abercrombie & Fitch catalog page illustrating defendants' turtle pin. According to the stipulation of March 15, 1974, defendants' selling price of the all ruby pin was \$95. and \$97.50 compared to plaintiff's selling price of \$245.

CHARLES SONNENREICH

(Sworn to by Charles Sonnenreich, April 1, 1974)

Stipulation Dated March 15, 1974 in Support of Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

IT IS HEREBY STIPULATED, CONSENTED AND AGREED, by and between the attorneys for the respective parties herein as follows:

1. The jeweled turtle pins which the defendants, Jerry J. Grossbardt and Stanley Schechter as co-partners trading as Honora Jewelry Co., manufactured and sold, which were the subject of the prior action in this Court, 68 Civil 4154, are shown on the photograph marked Plaintiff's Exhibit 1 for Identification in this action.

2. The aforementioned jeweled turtle pins were made with the jewels and combination of jewels as shown on said Exhibit

3. The defendant Honora Jewelry Co., Inc., since January 1971, has manufactured and sold jeweled turtle pins their style No. P3167R, (Defendants' Ex. B). The selling price was \$97.50 and \$95.00.

4. Defendants also manufactured and sold a smaller jeweled turtle pin same style as Exhibit B, which they identified as their style no. 3291R and was sold for \$80—\$102.50 Pl's Ex. 5.

Stipulation

5. Defendants made and sold jeweled turtle pins of the same design as Exhibit B employing all diamonds, sapphires and emeralds as well as combinations thereof. The following is their style Nos., and selling prices.

All diamond style no. 3167D selling price)	From
All emerald style no. 3167E selling price)	\$70 to
All sapphire style no. 3167S selling price)	\$107.50
Combination of gems)	

Dated: New York, N. Y.
March 15, 1974

CHARLES SONNENREICH
Attorney for Plaintiff

POLLACK & SINGER
Attorneys for Defendants

**Consent Decree in 68 Civ. 4154, Dated June 14, 1971
in Support of Motion**

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

68 Civ. 4154

HERBERT ROSENTHAL JEWELRY CORP.,

Plaintiff,

against

JERRY J. GROSSBARDT and STANLEY SCHECHTER, co-partners
trading as HONORA JEWELRY CO.,

Defendants.

Plaintiff having brought this suit against the defendants for infringement of Copyright Registration No. Gp56652 covering the design of a jeweled turtle pin and the plaintiff having moved this Court and the Hon. Charles W. Metzner, having granted plaintiff a preliminary injunction, holding plaintiff's copyright valid and infringed and restraining the defendants from further infringement of the same and the defendants having appealed to the United States Court of Appeals for the Second Circuit from the order granting the preliminary injunction and the said Court having affirmed the order appealed from and the parties hereto having agreed to settle their differences, it is,

Ordered, Adjudged and Decreed, that the defendants Jerry J. Grossbardt and Stanley Schechter, individually and as co-partners trading as Honora Jewelry, their agents, servants and employees, and all persons, firms and

Consent Decree

corporations acting by or in concert with or under them, their control, direction or license, whether directly or indirectly, be and they hereby are permanently enjoined from infringing plaintiff's copyright and from manufacturing and selling their style Sp2845 jeweled turtle pins and it is further,

Ordered, Adjudged and Decreed, that the parties having settled the amount of profits and damages to be recovered by the plaintiff, that there be no accounting therefor and that no costs, attorneys fees or disbursements be recovered by either party hereto.

Dated: New York, N. Y.
June 14, 1971

LASKER,
U. S. D. J.

The entry of the foregoing decree is consented to:

CHARLES SONNENREICH
Attorney for plaintiff

POLLACK & SINGER
Attorneys for defendants

HERBERT ROSENTHAL JEWELRY
CORP.,

By HAROLD M. ROSENTHAL

HONORA JEWELRY Co.,

By JERRY J. GROSSBARDT

STANLEY SCHECHTER

Affidavit of Daniel A. Pollack in Opposition to Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York,
County of New York—ss.:

DANIEL A. POLLACK, being duly sworn, deposes and says:

1. I am a member of the Bar of this Court and of the firm of Pollack & Singer, attorneys for the defendants in this copyright infringement action. I am familiar with the proceedings heretofore had herein and with the facts hereinafter set forth.

2. I make this affidavit in opposition to the plaintiff's motion for an order granting summary judgment against all the defendants (hereinafter collectively referred to as "Honora") and also granting a preliminary injunction against Honora.

3. This motion by the plaintiff (hereinafter referred to as "Rosenthal") must be denied because there are serious genuine issues of material fact with respect to it.

4. The deposition of Rosenthal, by its chairman of the board, Mr. Herbert Rosenthal, contains the following major admissions:

a. *Rosenthal admits that it does not have a copyright on ALL jeweled turtle pins (20:21-25):*

"Q. Do you think that you have a right to have a copyright on all turtle pins? A. Not on all turtle

Affidavit of Daniel A. Pollack

pins, but I specified specifically what I had as a copyright. Not on all turtle pins. That is ridiculous."

b. *Rosenthal admits that there are numerous differences between its jeweled turtle pin and Honora's jeweled turtle pin (9:13 to 13:6):*

"Q. Mr. Rosenthal, I show you your pin A and their pin B, and ask you whether you note any differences between them and, if so, whether you can tell us the differences? A. The differences, they are much lighter.

Q. Theirs is much lighter? A. Yes.

Q. Are there any other differences? A. Just the outside perimeter is different.

Q. In what respect? What is the outside perimeter difference? A. Mine is nugget gold and theirs is some attempt at it.

Q. Are there other differences? A. That is the only one I could see.

Q. Do you note for example that the tail on your pin is straight and that the tail on their pin is somewhat curved? A. Agreed.

Q. Do you note that your pin has jewelry stones in the eyes and their pin does not? A. Agreed.

Q. Do you note that your pin has flat feet and that their pin has feet that indicate toe differentiations? A. Right.

Q. Do you note that when you turn the pins backside up, that your pin has a gold base holding it together and their pin has no base holding it together? A. Right.

Q. Do you note that the head on your pin has a matted finish and that the head on their pin has

Affidavit of Daniel A. Pollack

a lined finish? A. Actually there is no difference between the matting. As far as the lined finish you need a loupe for that to find out what you mean by a lined finish.

Mr. Pollack: We will go back to that question when we get the loupe.

Q. Do you note that the head on your pin comes straight out from the body, whereas the head on their pin is at an angle from the body? A. Agreed.

Q. Is it correct that the body of your pin has 27 rounded section?

Mr. Sonnenreich: What do you refer to as a section?

Mr. Pollack: I would assume it would refer to these (Indicating.)

Mr. Sonnenreich: How would you describe it?

The Witness: Little nubs.

Q. Little nubs. Yes. Do you note there are 27 on your pin? A. Correct.

Q. Correct? A. Right.

Q. Do you note that the body of their pin has only ten rounded sections with straight lines, or ten nuggets, as you have described them, with straight lines?

Mr. Sonnenreich: That's not nuggets.

A. This is not nuggets. This is already lined sections.

Q. In other words the sections on their pin are different from the sections on yours? Yes? A. Right.

Q. And there are only ten on theirs? A. Right.

Affidavit of Daniel A. Pollack

Q. Do you notice that the model of your pin is two pieces with the top soldered on to the bottom frame? A. Yes.

Q. And that the model of their piece is all a single piece? A. That I would have to ask a jeweler, because it looks to me like two pieces on there. I would have to have an authority on it.

Q. Is it correct that your pin has an overall thickness of approximately eight millimeters? A. I would have to have a gauge to give you a direct answer.

Q. Well, without the gauge can you testify that the defendants' pin is half the thickness of the Rosenthal pin? A. Yes.

Q. We think one is eight millimeters and the other is four millimeters? A. Right.

Q. Do you note that your pin has a line for the mouth and their pin does not even have a mouth? A. Can I have the loupe, please? Yes."

c. Rosenthal admits that it has no evidence of copying by Honora (13:7-15):

"Q. Do you have any direct personal knowledge yourself that the defendants copied your pin? A. Direct knowledge?

Q. Yes, of your own personal knowledge? A. Now what do you mean? Now or before?

Q. I am talking about this pin? A. This particular pin?

Q. Yes. A. No."

5. On the basis of these sworn admissions alone, Rosenthal's motion for summary judgment and for a prelimi-

Affidavit of Daniel A. Pollack

nary injunction must be denied because there are clear disputed issues of material fact as to (a) copying and (b) infringement.

6. Moreover, as appears from the affidavit of the defendant Jerry J. Grossbardt, Honora not only denies copying but also shows documentary proof as to the source of their pin, separate and distinct from the plaintiff's pin. Also Honora denies that the pins are similar and sets out many differences between them. Finally, Honora raises a substantive issue regarding the validity of Rosenthal's copyright by virtue of the circulation of advertising which bore no copyright notice; other such examples may yet come to light prior to the trial of this action.

7. While the moving papers make much of the fact that Rosenthal had previously obtained the benefit of a consent decree and a preliminary injunction involving a different turtle pin, in a case in which copying was not an issue, these prior proceedings have no bearing upon the issues pertaining to *this* turtle pin, and this Court should not give them any weight whatever in reaching the conclusion that in this case, where both the fact of infringement and the fact of Rosenthal's observance, or non-observance, of the notice requirements of the Copyright Act are in dispute, Rosenthal is entitled neither to summary judgment nor to a preliminary injunction.

For the reasons stated, it is respectfully suggested that the plaintiff's motion be denied.

DANIEL A. POLLACK

(Sworn to by Daniel A. Pollack on April 15, 1974.)

Affidavit of Jerry J. Grossbardt in Opposition to Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York
County of New York—ss.:

JERRY J. GROSSBARDT, being duly sworn, deposes and says:

1. I am one of the defendants in this action and I am also an officer and director of the defendant Honora Jewelry Co., Inc. ("Honora"). I am personally familiar with the facts hereinafter set forth.

2. I make this affidavit in opposition to the plaintiff's motion for an order granting summary judgment in the plaintiff's favor and also granting to the plaintiff a preliminary injunction.

3. The plaintiff's motion should be denied for three reasons:

- a. Honora did not copy the plaintiff's pin;
- b. The plaintiff's pin and the Honora pin are not substantially similar—in fact, they are very different;
- c. The plaintiff may not even have a valid copyright, since there is evidence that the notice requirements of the Copyright Act were not observed.

Affidavit of Jerry J. Grossbardt

4. The turtle pin which Honora sold, and which has been copyrighted by Honora (*Exhibit A*), was never copied from any of the plaintiff's pins. The original Honora pin, which is not the pin at issue in any prior action, was made in Hong Kong at Honora's request by craftsmen who had never seen the plaintiff's pin nor any picture of such a pin. There instructions were in writing and true copies of those instructions and of the invoice for the initial shipment of Honora's pins are annexed to this affidavit (*Exhibits B and C*). Because this action is between two competitors, the name and address of the Hong Kong supplier has been blocked out, as was done at the defendants' deposition, but the original of these writings will be available for the inspection of the Court on the return day of this motion.

5. The Honora pin differs from the plaintiff's pin in many ways, including the following:

- a. The gold in the defendants' pin is much lighter in weight than that of the plaintiff's pin;
- b. The defendants' pin is two solid pieces, but the plaintiff's pin is three pieces soldered together;
- c. The back of the defendants' pin is open, but the back of the plaintiff's pin is covered;
- d. The defendants' pin is half the thickness of the plaintiff's pin;
- e. The head of the plaintiff's turtle juts straight out from its body, while the head of the defendants' turtle is placed at an angle;
- f. The head of the plaintiff's pin has a matted finish, whereas the head of the defendants' pin has a lined finish;

Affidavit of Jerry J. Grossbardt

g. The head of the plaintiff's pin is closely attached to the body by comparison with the defendants' pin, which extends further out;

h. The head of the plaintiff's pin shows a clearly demarcated mouth and two stones for eyes, but the head of the defendants' pin shows no mouth and the eyes are plain gold beads;

i. When viewed from the side, the heads are raised at distinctively different angles, the plaintiff's pin far less than the defendants' pin;

j. The plaintiff's pin has a short stubby tail, while the defendants' pin has a longer curved tail;

k. The body of the plaintiff's pin is divided into some 27 rounded sections, with a fringe of nugget gold, while the body of the defendants' pin is divided by straight lines into 10 sections and there is no such fringe;

l. The feet of the plaintiff's pin are flat and rounded off, whereas the feet of the defendants' pin show three clearly defined toes.

These distinctions, taken cumulatively, are evident to the naked eye and there can be no doubt that the defendants' pin was not copied from the plaintiff's pin. They are both turtles with stones—and that is not enough.

6. The defendants' memorandum of law filed in opposition to this motion shows that there can be no infringement where there was no copying and that the plaintiff could not have procured copyright protection for the mere idea of a jeweled turtle pin. The differences between

Affidavit of Jerry J. Grossbardt

the two pins are further proof that there was not and could not have been any copying. For these reasons alone the plaintiff's motion must be denied.

7. Finally, the defendants have raised the issue of whether the plaintiff lost any rights its copyright may originally have given by virtue of its failure to mark its pins or advertising material with the copyright notice required by Article 19 of the Copyright Act. Annexed hereto and marked *Exhibit D* are examples of advertising material for the plaintiff's pin which bear no indication of any copyright notice. This issue is not foreclosed by any prior preliminary injunction directed to a different pin or by any prior consent decree. Here is a second separate and distinct reason why no part of the plaintiff's motion can be granted. There remains for decision by the trier of fact not only the issue of infringement but the issue of whether there was anything to infringe.

For the reasons stated, it is respectfully suggested that the plaintiff's motion must be denied.

JERRY J. GROSSBARDT

(Sworn to by Jerry J. Grossbardt, April 15, 1974)

**Exhibit A, Copyright Certificate, Annexed to Foregoing
Affidavit in Opposition to Motion**

Included in Exhibit Volume.

**Exhibit B, Instructions Dated November 30, 1970,
Annexed to Foregoing Affidavit in Opposition
to Motion**

Included in Exhibit Volume.

**Exhibit C, Invoice Dated January 5, 1971, Annexed to
Foregoing Affidavit in Opposition to Motion**

Included in Exhibit Volume.

**Excerpt from Reply Affidavit of Herbert Rosenthal in
Support of Motion**

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

[SAME TITLE]

State of New York,
County of New York—ss.:

HERBERT ROSENTHAL being duly sworn deposes and says, I have read the affidavits submitted in opposition to plaintiff's motion for an injunction and summary judgment. Mr. Pollack in his affidavit cites certain portions from my deposition as to some minor changes defendants made in their pin which only tend to emphasize how deliberate was their intent to infringe plaintiff's copyright, Mr. Pol-

Excerpt from Reply Affidavit of Herbert Rosenthal

lack however, omits that portion of my testimony where I pointed out that the pin made by the defendants (Deft's. Ex. B) simulated the general design of plaintiff's pin (R. dep. pg. 19)

“Mr. Pollack: Can you tell us in what respects the pin that the defendants made simulated in design the design of your turtle pin? A. To begin with, the general design simulates my design.

Q. In what respect? A. Well, the whole contour, the whole concept, the whole idea, the whole design is similar in my estimation”

Mr. Pollack then quotes from a portion of my testimony where I was asked if I had any personal knowledge that the defendants copied my pin. I understood that question to mean that I personally was present when the defendants made their pin and saw them use mine as a model. Of course I could not under those circumstances give an affirmative answer.

Mr. Grossbardt in his affidavit urges that defendants did not copy plaintiff's pin, that the pins are substantially dissimilar and that the notice requirements of the Copyright Act were not observed. Mr. Grossbardt points out certain structural differences between the two pins. He refers to defendants' use of lighter gold, the use of two solid pieces instead of three, the open back of defendants and the differences in the thickness of the two pins. All of these structural changes were made by defendants to enable them to put out a cheaper product so that they could undersell plaintiff which they did. But nevertheless defendants still retained the general overall appearance of the plaintiff's pin.

Excerpt from Reply Affidavit of Herbert Rosenthal

The defendants urge they did not copy from plaintiff. Where else did they get the design of their pin? Originally they had one of plaintiff's which they admittedly copied to the last detail. The general appearance of defendant's pin including the same oval shape back with the ten stones in a cluster, is so identical to plaintiff's so as to leave no doubt that one was taken from the other. The use of the same gems and combination of gems as plaintiff further should convince this Court of defendants' intention to closely simulate plaintiff's pin.

The defendants submit copies of letters (Ex. B & C) sent to some firm in Hong Kong, whose name they keep secret as proof that they did not copy from plaintiff. The Hong Kong firm is asked to make turtle pins "using the same motif" as used in other pins previously ordered by defendants. It should be obvious to this Court that the "motif" is that of the back of plaintiff's pin. Other than defendants' bare statement that it did not copy from plaintiff, nothing is submitted to corroborate this contention. Not a word from the so called "originators". Hundreds of plaintiff's pins have been sold throughout the United States and the world since 1967 and it may well be that knowledge of this design even reached Hong Kong. Furthermore it is a well known fact in the jewelry industry that the jewelry manufacturers in Hong Kong are known pirates of American designs.

* * *

HERBERT ROSENTHAL

(Sworn to by Herbert Rosenthal on April 19, 1974.)

**Reply Affidavit of Charles Sonnenreich in Support of
Motion**

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York,
County of New York—ss.:

CHARLES SONNENREICH, being duly sworn deposes and says, I have read the affidavits submitted in opposition to the motion. The affidavits fail to present any facts to indicate genuine issues to be tried by this Court. Defendants do not here as in the prior litigation involving this same copyright question the originality of plaintiff's design. Defendants have not presented one iota of proof that plaintiff failed to mark its pins from the inception with the copyright notice as alleged in their affirmative defense. To be sure this issue is moot because it was litigated against these same defendants in the prior litigation against them.

The attempts by the defendants to charge plaintiff with the failure of others to indicate that plaintiff's pin was copyrighted fails as a matter of law which will be pointed out in plaintiff's memorandum of law submitted herewith.

The defendants would have this Court believe that they are innocent of copying and refer to some copy of correspondence had with their manufacturing source in Hong Kong. There is nothing to indicate what design the

Reply Affidavit of Charles Sonnenreich

source duplicated in making the turtle in 1970, 1971. It may well be that these were entirely different from the ones involved here now. The correspondence is dated Nov. 30, 1970. The invoice Ex. C is dated Jan. 5, 1971. Yet the application for copyright registration which defendants filed November 19, 1973, *12 days after* deponent wrote Abercrombie & Fitch that they were infringing plaintiff's copyright by selling turtle pins purchased from defendants, the defendants stated the date of publication, or sale of the turtle pins as *March 30, 1972*. This was more than a year after Hong Kong was supposed to have shipped what defendants now claim to be the turtle in suit. (See Defts Ex. A.)

Both dates cannot be correct, either defendants are attempting to mislead the Court or defraud the Copyright Office. This practice of using invoices of foreigners to bolster their defenses is not new with the defendants. In the jeweled bee case 67 Civ. 4674) Judge Palmieri found for the plaintiff after trial. Before the entry of judgment, defendants moved for a new trial upon the grounds of newly discovered evidence. This consisted of an invoice from a Florence, Italy jeweler covering a supposedly sale of a bee pin before plaintiff's designer had created his. The inference attempted to create, was that plaintiff's designer had gone to Florence, saw the original there and came back to The United States, copied it and sold it as original.

Your deponent went to Florence and accompanied by an Italian attorney Renzo Rava, formerly with the firm of Root, Clark, Buckner and Ballantine of New York, spoke to the retailer who supposedly sold the bee pin. It turned out that the invoice submitted by defendants was

Reply Affidavit of Charles Sonnenreich

never issued by the individual. Nor was the individual named as the purchaser listed on his records of export sales. (See affidavit of Renzo Rava, Esq., 67 Civ. 4674)

The sole question to be determined by the Court on this motion is that of infringement. This can easily be done by a visual comparison of the pins and applying the test established in this Circuit that "the similarity between the products would lead an average lay observer to recognize the alleged copy as having been appropriated from the copyrighted work". The appropriation is obvious.

CHARLES SONNENREICH

(Sworn to by Charles Sonnenreich April 19, 1974.)

Rebuttal Affidavit of Stanley Schechter in Opposition to Motion

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

[SAME TITLE]

State of New York
County of New York—ss.:

STANLEY SCHECHTER, being duly sworn, deposes and says:

1. I am a defendant in this action and I am familiar with the proceedings heretofore had herein and with the

Rebuttal Affidavit of Stanley Schechter

facts hereinafter set forth. I make this affidavit in opposition to the plaintiff's motion for summary judgment, the issuance of a preliminary injunction and other relief. I have read the affidavits of Herbert Rosenthal and Charles Sonnenreich filed in support of this motion and this affidavit is filed in reply thereto.

2. Mr. Rosenthal urges that the only way Honora Jewelry Co., Inc. ("Honora") could have produced a turtle pin set with stones was to copy the plaintiff's pin. This is nonsense. Originally Honora produced a fly pin set with a single stone. Thereafter I requested our Hong Kong supplier to make an owl and a turtle to be set with a single stone, such as coral. The owl pin thus set sold well. The turtle pin did not. So Honora took the very same turtle pin, previously set with a single stone, and set it with a cluster of stones instead. If any copying was done it was from *Honora's* own pin and not from any pin made by the plaintiff.

3. In this connection, Mr. Sonnenreich alleges that the defendants are "attempting to mislead this Court or defraud the Copyright Office". Vulgar abuse is no substitute for honest advocacy. The dates given by the defendants are quite correct. The original turtle pin was supplied by our Hong Kong supplier early in 1971, but the jeweled turtle pin of which the plaintiff complains was not issued prior to March 30, 1972.

4. It is the plaintiff that seeks to mislead this Court when its officer claims that the plaintiff does not know where Lemon and Sons obtained the illustration for the jeweled turtle pin. This morning, April 24, 1974, I had a

Rebuttal Affidavit of Stanley Schechter

conference with Mr. Robert Carp, whose firm, Robert Carp Inc., located at 630 5th Avenue, New York, New York, copyrighted the Lemon and Sons catalog. The plaintiff must know, because all the firms in our industry know, that each year Robert Carp Inc. publishes a catalog which is the same except for the names of the prestigious local jewelers appearing on it. Mr. Carp told me that at least 35 firms besides Lemon circulated this catalog, including the plaintiff's pin, in 1968. In order to obtain representation in this catalog a manufacturer must *ask* for such representation. No item is ever photographed or published without the manufacturer's consent, which is eagerly given because the Carp catalogs are widely circulated. Moreover, only part of the items submitted by a manufacturer for inclusion in this catalog are ever accepted. In short, the plaintiff had to give permission for its jeweled turtle pin to appear in this catalog—usually such permission is sought as a privilege—and for every item depicted therein to be photographed. This being so, such publication can never be inadvertent and if the plaintiff now claims that it was the plaintiff lies.

5. I received from Mr. Carp this morning nine other catalogs, each dated 1968 and bearing the name and address of a different jewelry house, which include and depict the plaintiff's jeweled turtle pin. Given time to search for them, doubtless many others may be found. It seems quite clear that the plaintiff gave up any copyright privileges it may have had by this publication, without any copyright notice indicating any right, title or interest claimed by the plaintiff, on the widest scale.

6. Moreover, the plaintiff now appears to allege that it has a copyright in the way in which the stones are

Rebuttal Affidavit of Stanley Schechter

arranged on the turtle (ten stones in a cluster). When Honora applied for the copyright on its pin I was advised by the Copyright Office that a mere arrangement of stones cannot be protected by copyright, nor can the means by which the stones are fastened into or onto a piece of jewelry be so protected. Only the entire pin may be the subject of such protection. The defendants have instructed their attorneys to communicate with the Copyright Office in the hope and expectation of obtaining written confirmation of this rule.

7. The attempt by the plaintiff to show that no issues of fact exist which would bar summary judgment has simply underscored the issues of fact which do exist. The defendants did *not* copy the plaintiff's pin and it now is likely that there would have been no infringement if they had copied it because of the publication of that pin without a copyright notice, not once, but thousands of times. Thus summary judgment must be denied. And given the questionable nature of the claim of infringement, and, more so, of the claim that there remained anything to be infringed, the preliminary injunction sought by the plaintiff must also be denied.

STANLEY SCHECHTER

(Sworn to by Stanley Schechter, April 24, 1974)

**Excerpts from Deposition of Jerry J. Grossbardt Taken
February 27, 1974**

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

[SAME TITLE]

Examination before trial of the Defendants, Honora Jewelry Co., Inc., by Jerome Grossbardt, taken by the Plaintiff, pursuant to notice, at the offices of Messrs. Pollack & Singer, 61 Broadway, New York, New York, on Wednesday, February 27, 1974, at 11:30 a.m., before William S. Davis, Certified Shorthand Reporter and Notary Public in and for the State of New York.

(2)

A P P E A R A N C E S :

CHARLES SONNENREICH, Esq., Attorney for Plaintiff, 500 Fifth Avenue, New York, New York 10036.

POLLACK & SINGER, Esqs., Attorneys for Defendants, 61 Broadway, New York, New York.

By: **DANIEL A. POLLACK, Esq.** and
NEIL D. THOMPSON, Esq., of counsel.

IT IS HEREBY STIPULATED AND AGREED by and between counsel for the respective parties hereto that the sealing, filing and certification of the within examination be waived; that such examination may be signed and sworn to by the witness being examined before any officer authorized to administer an oath with the same force and effect as if signed and sworn to before the officer before whom said examination is taken.

Excerpts from Deposition of Jerry J. Grossbardt

IT IS FURTHER STIPULATED AND AGREED that all objections, except as to the form, are reserved to the time of trial.

(3)

JEROME GROSSBARDT, called as a witness, having been first duly sworn by the Notary Public was examined and testified as follows:

Examination by Mr. Sonnenreich:

Q. Mr. Grossbardt, are you an officer of Honora Jewelry Co., Inc.? A. Yes.

Q. What office do you hold? A. Vice President.

Q. And is their place of business still at 42 West 48th Street in the Borough of Manhattan, City of New York? A. Yes.

Q. Who are the other officers of the defendant? A. Stanley Schechter.

Q. And are you and Mr. Schechter the sole stockholders of the defendant corporation? A. Yes.

. . .

(4)

Q. Were you and Mr. Schechter formerly copartners trading as Honora Jewelry Company? A. Yes.

. . .

(5)

Q. I show you a paper and ask you—this is a copy—does this paper bear your signature and that of Mr. Schechter? (Handing to witness.) A. I don't know what the paper is. It is my signature.

Q. I just asked you if it is yours and Mr. Schechter's signature. A. It is my signature. It looks like his signature but I don't really know. It looks like his signature.

Excerpts from Deposition of Jerry J. Grossbardt

Mr. Sonnenreich: May I ask that be marked as Plaintiff's Exhibit 2.

(Copy of a document, consent decree, marked Plaintiff's Exhibit No. 2 for identification.)

Q. Do you recall that in 1968 you and Mr. Schechter as copartners trading as Honora Jewelry Company were sued by Herbert Rosenthal Jewelry Corporation for infringement of a copyright covering the design of a jeweled turtle pin? A. Yes.

. . .

(11)

By Mr. Sonnenreich:

Q. I show you a pin, Mr. Grossbardt, marked Defendants' Exhibit B on the deposition of Mr. Rosenthal and ask you whether you can identify this as a pin manufactured and sold by the defendant corporation, Honora Jewelry Co., Inc.? A. Yes.

. . .

(12)

Q. When did you start to manufacture pins such as Defendants' Exhibit B? A. Early '71.

Q. Can you give me the exact date when you started to manufacture?

Mr. Pollack: If you leave a blank in the transcript we will fill it in.

Mr. Sonnenreich: If he knows now—

The Witness: The exact date I don't know now.

Q. Was there a model made? A. Yes.

Q. Who made the model?

Mr. Pollack: I will object, not because I don't think the information is relevant, but because I

Excerpts from Deposition of Jerry J. Grossbardt

think it involves a trade secret and, although we are willing to make this information available to the Court in camera, we are not willing to make it available to your client.

I will state for the record that we have the original order placed by Honora for the pin.

* * *

(13)

Mr. Pollack: And wait. We also have the confirmation from the maker of the pin to Honora. Both of those will be made available to the Court should the Court wish to see them or use them, but I think you can understand in view of the antagonistic relations between these parties who are in the same business, we are not willing to make those available to you at this time.

Q. Was the model made in your place of business or by an outside source? A. By an outside source.

Q. Was this source a model maker? A. Yes.

Q. Did you place a written order for this model? A. Yes.

Q. You paid for it by check? A. Yes.

Q. Do you have the order, the invoice and the check? A. Yes.

Q. Did anyone in your employ, that of you or Mr. Schechter, give instructions to the model makers what to make?

(14)

Q. Who was the person who gave the instructions? A. Mr. Schechter.

Q. Were those instructions in writing or oral? A. In writing.

Q. Do you have a copy of those instructions? A. Yes.

Q. Do you have them with you?

Excerpts from Deposition of Jerry J. Grossbardt

Mr. Pollack: As I said, we will make that available to the Court in camera, should the Court wish to see it.

* * *

(15)

Q. You notice on Defendant's Exhibit B, before you, there is a cluster of ten stones on the back of the turtle?

A. Did you say Exhibit B?

Q. Exhibit B.

(16)

A. Yes.

* * *

Q. I show you Defendants' Exhibit A. Do you find a cluster of stones in the shape of an oval on the back of the turtle? I am just asking you about the one, Exhibit A. A. It is almost an oval.

Q. And also there are ten stones, is that correct? A. Yes.

* * *

(21)

Q. Do I understand then as far as Defendants' Exhibit B is concerned, this is the only size you made of this jeweled turtle pin? A. No.

* * *

(22)

Q. Do you make it in any other size? A. Yes, I make it in a smaller size.

Q. I see. Employing how many stones? Is the design identical to that of Defendants' Exhibit B? A. Yes.

* * *

(23)

Mr. Pollack: Mr. Sonnenreich, you had asked earlier as to whether we had the original order and

Excerpts from Deposition of Jerry J. Grossbardt

instruction for the making of the turtle pin sold by defendant. I told you that I would seek to obtain that for you and give it to you with the name blanked out, which you indicated was satisfactory. I have that letter and I produce it for you.

I also have the invoice of the first sale to the defendant of the piece made by the maker, which I also produce for you.

I would suggest that each be marked for identification.

Mr. Sonnenreich: All right. You have produced—

Mr. Pollack: Perhaps we can mark the order letter Defendants—

* * *

Mr. Sonnenreich: Let's make it I and J

(24)

of this deposition. The letter of November 30 would be I and the invoice would be marked J.

(Letter dated November 30th marked Defendant's Exhibit I for identification.)

(Copy of an invoice marked Defendants' Exhibit J for identification.)

Q. Your attorney has produced Defendants' Exhibits I and J. Is I the only written instructions issued to the model maker by the Defendant corporation? A. As far as I know these are the only instructions.

* * *

Q. Now I direct you attention to the last paragraph of Defendants' Exhibit I, which instructs the individual to whom the letter is addressed, to make an inexpensive turtle pin in two sizes using the same motif.

Do you know what M. F. is referred to and what object?

Excerpts from Deposition of Jerry J. Grossbardt

Mr. Pollack: First, may we establish for the record that Exhibit I was not written by this witness.

* * *

(26)

Q. Now you sold pins such as Defendants' Exhibit B to Abercrombie and Fitch? A. Yes.

* * *

(27)

Q. Does the defendant make pins such as Defendants' Exhibit B employing other gems than rubies? A. Yes.

Q. What other gems? A. Sapphires, emeralds, diamonds.

* * *

(33)

Q. Do you know that Abercrombie and Fitch illustrated the pin, Defendants' Exhibit B, in their Christmas catalogue? A. Yes.

Q. I show you page eleven of the Christmas 1973

(34)

catalogue of Abercrombie and Fitch and direct your attention to the item indicated by J.

Is that your pin illustrated there, Defendants' Exhibit B? A. Yes.

Mr. Sonnenreich: Mark that Plaintiff's Exhibit 4.

(Copy of page eleven of Christmas 1973 catalogue of Abercrombie and Fitch, Item J, marked Plaintiff's Exhibit No. 4 for identification.)

* * *

(35)

Q. Are you still manufacturing and selling pins like Defendants' Exhibit B? A. Yes.

* * *

**Deposition of Herbert Rosenthal Taken
February 27, 1974**

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

[SAME TITLE]

Examination before trial of the Plaintiff, Herbert Rosenthal Jewelry Corporation, by Herbert Rosenthal, taken by Defendants, pursuant to notice dated December 5, 1973 and stipulation of adjournment, at the offices of Messrs. Pollack & Singer, 61 Broadway, New York, New York, on Wednesday, February 27, 1974, at 10:00 a.m. before William S. Davis, Certified Shorthand Reporter and Notary Public in and for the State of New York.

(2)

A P P E A R A N C E S :

**CHARLES SONNENREICH, Esq., Attorney for Plaintiff, 500
Fifth Avenue, New York, New York 10036.**

**POLLACK & SINGER, Esqs., Attorneys for Defendants, 61
Broadway, New York, New York 10006.**

**By: DANIEL A. POLLACK, Esq. and
NEIL D. THOMPSON, Esq., of counsel.**

**IT IS HEREBY STIPULATED AND AGREED by and between
counsel for the respective parties hereto that exhibits
may be retained in the possession of the party producing
same subject to the inspection at reasonable hours by**

Deposition of Herbert Rosenthal

opposing counsel; all objections reserved except as to form.

It will be signed before any Notary Public and the filing can be waived.

(3)

HERBERT ROSENTHAL, called as a witness having been first duly sworn by the Notary Public was examined and testified as follows:

Examination by Mr. Pollack:

Q. Mr. Rosenthal, are you affiliated with Herbert Rosenthal Jewelry Corp.? A. Yes.

Q. The plaintiff in this action? A. Yes.

Q. In what capacity? A. Chairman of the Board.

Q. Is that an office? A. Yes.

Q. Do you hold any other office in the corporation? A. No.

Q. Can you state the function that you perform in the corporation? A. The function I perform is to oversee all the activities of the salesmen and administer whatever is necessary for the corporation.

Q. Are you a designer, yourself, of jewelry? A. Not actually designated a designer. I do create.

Q. Do you have a designer in the direct employ

(4)

of the corporation? A. No.

Q. Did there come a time when you made a turtle pin? A. Yes.

Q. Has Herbert Rosenthal Jewelry Corporation made more than one turtle pin? A. Oh, yes.

Deposition of Herbert Rosenthal

Q. How many different models of turtle pin has Herbert Rosenthal Jewelry Corporation made? A. Are we talking about the one in question? We have other turtle pins.

Q. Can you tell us the full spectrum of turtle pins that you make? A. Well, the three turtle pins that we have consist of one of a total of a carat, one of two carats and one of five carats.

Then we have various positions of turtles, a turtle looking backwards, with his neck completely turned around. That is about it.

Q. What other positions do you have? A. That's it. The one with the neck completely turned around looking backwards.

Q. Is that the only—

(5)

A. The only other one, yes.

Q. When you say the only other one, the only other one what? A. The other three. In other words I have given you a description of four turtle pins.

Q. The first three you described by their weight, not by their position.

Can you describe them by their positions? A. The positions, on the first turtle pin we have ten stones on top. Now I also think that we have on the second, on the two carat, ten stones. But on the five carat we have 16 stones.

Q. Which is the turtle pin at issue in this lawsuit? A. The carat weight turtle pin.

Q. So that is one of the four turtle pins made by the Herbert Rosenthal Jewelry Corporation? A. Right.

Q. Can you describe the pin at issue, in other words the one that is made by Herbert Rosenthal Jewelry Corporation of a carat weight? A. Yes, it is a pin that has ten

Deposition of Herbert Rosenthal

stones on the top, averaging ten points apiece, making a total weight of a carat.

(6)

Q. Can you give any further description of the pin?

A. Yes. It is made of, the description is nugget gold around the perimeter or fringes, four feet, a protruding neck.

Q. Any other description? A. That is about it.

Q. Do you have with you an example of that pin? A. Yes.

Mr. Pollack: Please mark this Defendant's Exhibit A for identification.

(Turtle pin marked Defendant's Exhibit A for identification.)

Q. When for the first time did Herbert Rosenthal Jewelry Corporation make this pin? A. Approximately in February or March of 1967.

Q. Do you have a mold of the original pin? A. I don't have it. My designer-manufacturer has it.

Q. Who is that? A. Peter Lindeman.

Q. Where is he located? A. 548—

Mr. Sonnenreich: 580.

The Witness: No, he is not in 580.

(7)

Excuse me. 588 Fifth Avenue.

Q. Was it Peter Lindeman who designed the pin? A. In collaboration with Herbert and Harold Rosenthal.

Q. Does Peter Lindeman now still have possession of the mold of the pin? A. Yes.

Deposition of Herbert Rosenthal

Q. Has there been more than one mold for this turtle pin? A. No.

Q. Do you have a bill for the mold of the turtle pin? A. I am sure that we do have, but I would have to get that.

Q. You say that Peter Lindeman designed this pin in collaboration with Herbert and Harold Rosenthal. Can you state the contribution of each of the three persons?

A. Yes. Well, my brother and myself usually would go to Peter and tell him what we would like to have him make for us. After all, we do get out in the field and get expressions from customers what they could sell. Sometimes these expressions are meaningful, sometimes they are not. So we interpret what

(8)

they want. And at that particular time the bunching of the diamonds, the bunching up of diamonds was an important factor for us. So we finally asked Peter what he had or what he could come up with, and it seemed the vogue was for turtles at that particular time. So we told him to get to work and start making a turtle for us. And also told him that we would like him to arrange the top in a certain way that we could use it as the total weight of the carat.

Q. Did you give him any other instructions? A. At that particular time, no.

Q. Did you ever thereafter give him any instructions? A. Yes. When the turtle was starting to sell well, I said now, Peter, let's make a two carat turtle.

Q. But did you give him any other instructions with respect to the design of the one carat turtle. A. No, we

Deposition of Herbert Rosenthal

just followed through step by step as to what constituted a turtle and it was up to him to make it.

Q. Do you claim that the defendants are infringing any of your turtles other than the one carat turtle pin? A. No.

(9)

Q. Have you seen an example of the defendants' pin that you claim is infringing— A. Yes.

Q. —Your pin? Do you have such an example? A. Yes.

Mr. Sonnenreich: I don't have any tag on that.

Mr. Pollack: Please mark this Exhibit B for identification.

(Example of defendants' pin marked Defendants' Exhibit B for identification.)

Q. Mr. Rosenthal, I show you your pin A and their pin B, and ask you whether you note any differences between them and, if so, whether you can tell us the differences? A. The differences, they are much lighter.

Q. Theirs is much lighter? A. Yes.

Q. Are there any other differences? A. Just the outside perimeter is different.

Q. In what respect? What is the outside perimeter difference? A. Mine is nugget gold and theirs is some attempt at it.

(10)

Q. Are there other differences? A. That is the only one I could see.

Q. Do you note for example that the tail on your pin is straight and that the tail on their pin is somewhat curved? A. Agreed.

Deposition of Herbert Rosenthal

Q. Do you note that your pin has jewelry stones in the eyes and their pin does not? A. Agreed.

Q. Do you note that your pin has flat feet and that their pin has feet that indicate toe differentiations? A. Right.

Q. Do you note that when you turn the pins backside up, that your pin has a gold base holding it together and their pin has no base holding it together? A. Right.

Q. Do you note that the head on your pin has a matted finish and that the head on their pin has a lined finish? A. Actually there is no difference between the matting. As far as the lined finish you need a loupe for that to find out what you mean by a lined finish.

(11)

Mr. Pollack: We will go back to that question when we get the loupe.

Q. Do you note that the head on your pin comes straight out from the body, whereas the head on their pin is at an angle from the body? A. Agreed.

Q. Is it correct that the body of your pin has 27 rounded sections?

Mr. Sonnenreich: What do you refer to as a section?

Mr. Pollack: I would assume it would refer to these. (Indicating.)

Mr. Sonnenreich: How would you describe it?

The Witness: Little nubs.

Q. Little nubs. Yes. Do you note there are 27 on your pin? A. Correct.

Q. Correct? A. Right.

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Q. Do you note that the body of their pin has only ten rounded sections with straight lines, or ten nuggets, as you have described them, with straight lines?

Mr. Sonnenreich: That's not nuggets.

A. This is not nuggets. This is already lined

(12)

sections.

Q. In other words the sections on their pin are different from the sections on yours? Yes? A. Right.

Q. And there are only ten on theirs? A. Right.

Q. Do you notice that the model of your pin is two pieces with the top soldered on to the bottom frame? A. Yes.

Q. And that the model of their piece is all a single piece? A. That I would have to ask a jeweler, because it looks to me like two pieces on there. I would have to have an authority on it.

Q. Is it correct that your pin has an overall thickness of approximately eight millimeters? A. I would have to have a gauge to give you a direct answer.

Q. Well, without the gauge can you testify that the defendants' pin is half the thickness of the Rosenthal pin? A. Yes.

Q. We think one is eight millimeters and the

(13)

other is four millimeters? A. Right.

Q. Do you note that your pin has a line for the mouth and their pin does not even have a mouth? A. Can I have the loupe, please? Yes.

Q. Do you have any direct personal knowledge yourself

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that the defendants copied your pin? A. Direct knowledge?

Q. Yes, of your own personal knowledge? A. Now what do you mean? Now or before?

Q. I am talking about this pin? A. This particular pin?

Q. Yes. A. No.

Q. Did I ask you whether you had a stamp?

Mr. Sonnenreich: Yes. We do have.

Q. Which you used to stamp this pin?

(Stamp produced.)

Q. Is this the stamp you used to stamp your turtle pin?

A. Yes.

Q. The one carat pin in issue? A. Yes.

Q. When did you obtain this stamp?

(14)

A. We have had stamps since 1962.

Q. Do you know when you obtained this stamp? A. I would have to check it out with the department that handles that.

Q. There is a date on it that appears to indicate 12/69. Would that indicate to you that it was purchased in December of 1969? A. Yes. We have had subsequent pins, previous pins.

Mr. Sonnenreich: Pins or stamps?

A. Because we, you know—a stamp wears out and we have to get them done again and again.

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Q. Do you have any advertising which shows the one carat turtle pin? A. Yes.

Q. May we have that, please?

Mr. Pollack: Please mark this stamp Defendant's Exhibit C for identification.

(Stamp marked Defendant's Exhibit C for identification.)

(Mr. Sonnenreich produces documents.)

Q. Are there any other advertising materials showing the one carat turtle pin other than the two that your counsel has just produced?

Mr. Sonnenreich: We have some of customers.

(15)

Mr. Pollack: Do you have those with you?

Mr. Sonnenreich: I have some, yes.

Mr. Pollack: Please mark the two documents which were produced by Rosenthal as Defendants' Exhibit D.

Mr. Sonnenreich: Why don't you mark them separately?

Mr. Pollack: All right. The smaller of the two will be Defendants' Exhibit D for identification. The larger of the two Defendants' Exhibit E for identification.

(Smaller pin marked Defendants' Exhibit D for identification.)

(Larger pin marked Defendants' Exhibit E for identification.)

Mr. Pollack: Please mark the Zell Brothers advertisement as Defendants' Exhibit F for identification

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and the Laykin advertisement Defendants' Exhibit G, for identification.

(Copy of Zell Brothers advertisement marked Defendants' Exhibit F for identification.)

(Copy of the Laykin advertisement marked Defendants' Exhibit G for identification.)

(16)

Mr. Pollack: And please mark the smaller Laykin advertisement as H.

(Copy of the smaller Laykin advertisement marked Defendants' Exhibit H for identification.)

Q. Did any customers other than Laykin, or Zell put out advertising materials showing your pin? A. Usually when they put out an important ad like any one of these, I would have copies made, but if anything—I haven't come across any other ads where they put out a single piece.

Oh, you are taking it down. Okay.

Q. Were these ads that were put out by your customers done with your approval? A. No. I didn't know that they had put them out. The only time I saw them is when they were done.

Q. Did you disapprove of them or protest to them about the putting out of these advertisings? A. I did.

Q. To whom did you protest? A. All of them.

Q. To whom did you protest to at Laykin? A. Sol himself.

Q. And to whom did you protest at Zell? A. Marty Zell.

(17)

Q. What was the nature of the protest? A. They were supposed to put the copyright, the C in the circle, the

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copyright in there and I took issue with them that they will do it the next time.

Q. Did you ever thereafter tell them to stop publishing the advertisements in this form? A. I did tell them.

Q. Did they do so? A. They didn't do anything further about it. This was the end result of the ad.

Q. In what year did the Laykin ad appear? A. Oh, well, I would have to check the file on that.

Mr. Sonnenreich: The little one has a date.

The Witness: Oh, yes. From the New Yorker Magazine.

Q. November 23, 1968. In what year did the Zell Brothers ad appear? A. Maybe a year later. I would have to look it up.

Q. Did you make your protest to Laykin in writing? A. No, over the phone.

Q. Did you make your protest to Zell in writing?

(18)

A. Over the phone.

Q. Did you make any memorandum in writing of either protest? A. No. We knew them intimately enough to be able to talk to them this way.

Q. Did any customer other than Zell or Laykin make an advertisement showing your pin? A. Not that I am aware of. They may have but it wasn't important enough, obviously. If it was I would have known about it.

Q. How many of the one carat turtle pins did you sell? A. Did I sell? Four, five, six hundred. I don't know.

Q. At what prices? A. As the diamond prices went up, prices of the turtle went up.

Q. Approximately what were the prices? A. Anywhere

Deposition of Herbert Rosenthal

from a carat total weight, say from 245 up to four and a quarter today.

Q. The gist of your paragraph twelve in your complaint is that the individual defendants, acting through the corporate defendant, commenced to manufacture and sell turtle jeweled pins simulating in design the

(19)

design of plaintiff's copyright turtle pin.

Can you tell us in what respects the pin that the defendants made simulated in design the design of your turtle pin? A. To begin with, the general design simulates my design.

Q. In what respect? A. Well, the whole contour, the whole concept, the whole idea, the whole design is similar in my estimation.

Q. Well, surely you do not claim that a turtle is something that is copyrighted to you, that the idea of a turtle, jeweled turtle pin is copyrighted to you, do you? A. Well, that particular one with the ten stones on top is definitely my type of design.

Q. Well, is that what makes it special to you, the ten stones on top? A. To me, to my thinking, it is special to me.

Q. The ten stones? A. Yes.

Q. Is there anything else that makes it special to you? A. And the whole concept of the turtle with ten stones.

(20)

Q. In other words, someone could make a turtle without the ten stones and he wouldn't be infringing your copyright, is that correct? A. Right.

Q. Is there any other element of it besides the ten stones

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which you claim is unique to you? A. Well, that is what I am basing my complaint on.

Q. The ten stones? A. Ten stones and the general idea to simulate my type of turtle.

Q. Well, can you explain or specify what in addition to the ten stones is unique to your pin? A. Merely by turning the head one way and turning the tail another way does not eliminate the general concept of the turtle.

Q. Well, you don't claim that the general concept of the turtle is something that you have a right to copyright, do you? A. I think so.

Q. Do you think that you have a right to have a copyright on all turtle pins? A. Not on all turtle pins, but I specified specifically what I had as a copyright. Not on all turtle pins. That is ridiculous.

(21)

Q. Can you tell us what turtle pins would not be within your copyright?

Mr. Sonnenreich: I object to that as argumentative.

Q. Can you give us an example of a turtle pin that would not come within your copyright?

Mr. Sonnenreich: I object to that as argumentative and not within the issues here and I don't think the witness has to answer that.

Q. Is there anything other than the ten stones that you can point to as being the essence of what you claim you have a right to copyright?

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Mr. Sonnenreich: The witness has already answered that question, Mr. Pollack.

Mr. Pollack: If he has, I am not clear on what answer he gave.

Mr. Sonnenreich: You don't like his answer.

Mr. Pollack: No, I am delighted with his answer but I don't understand it.

Mr. Sonnenreich: He told you what it was.

The Witness: I am glad you are.

Q. Is there any other respect other than the ten stones in which— A. I have answered the question. I told you, the

(22)

general concept, the general design. You went into specifics. That is immaterial in my book.

Q. Could you tell me what you mean by the general concept or general design? A. Pardon me. I didn't hear you.

Q. Can you tell me what you mean by the general concept or general design? A. There is a turtle there with a top on it with ten stones and all the arrangements that surround it make up the general concept of the turtle.

Q. Is that what your copyright is all about? A. That's right. You can see that nobody else has made up the turtle.

Q. Would it be your position that any turtle pin that has ten stones in it would infringe your copyright? A. Let me go one step further.

Q. Please answer that question first and then go one step further? A. You don't want extra information? Yes.

Q. Mr. Rosenthal, do you have possession of the original model, not the mold, but the original model of the turtle

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pin? A. Original model? Most likely we have taken that and sold it. I don't know. That is a

(23)

question that I have to look into.

Q. Is it customary to sell a model of a pin? A. Not—well, I see what you mean. You mean the silver model?

Q. Yes. A. Or the casting itself? No, it is not customary.

Q. Was the model in this case made in gold or in silver? A. It was made in gold.

Q. Is it customary to sell a model that is made of gold? A. Usually you keep it for sentimental reasons, period.

Q. Did you do so in this case? A. I don't know. I would have to talk to my manufacturer.

Q. Mr. Rosenthal, isn't it true that the mold wears out over time and that you have to retain the model not for sentimental reasons but in order to make another mold?

A. You could make another mold from succeeding turtles.

Q. Did anybody other than Peter Lindeman ever manufacture this turtle pin for you? A. No.

(24)

Mr. Pollack: Off the record.

(Discussion off the record.)

Mr. Pollack: Back on the record.

I have no further questions of the witness at this time.

Mr. Sonnenreich: I have a couple of questions I want to ask.

Examination by Mr. Sonnenreich:

Q. Mr. Rosenthal, at the time there was a discussion about designing a turtle pin, was the plaintiff, Herbert

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Rosenthal Manufacturing Corporation, manufacturing a jeweled bee pin? A. Yes.

Mr. Pollack: I object as not relevant and as improper questioning in this action.

Q. Did the bee have a cluster of stones averaging one carat on the back? A. Yes.

Mr. Pollack: Objection. Irrelevant and not proper questioning.

Q. Was the arrangement of the cluster of stones on the back of the bee similar to that shown on Defendants' Exhibit A?

Mr. Pollack: Objection, not relevant, not
(25) proper cross-examination. This action is about turtles, not about bees.

A. That's correct. Similar.

Q. Did the plaintiff manufacture its jeweled turtle pin using different gems? A. Yes.

Q. What other gems did the plaintiff use? A. Sapphires, rubies and emeralds.

Q. I show you a photograph and ask you whether that illustrates the various combinations of gems used by the plaintiff in manufacturing their jeweled turtle pin? A. Yes.

Mr. Sonnenreich: I should like to mark this as Plaintiff's Exhibit 1.

Mr. Pollack: Show it to your adversary.
May I have a voir dire on this exhibit?

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Mr. Sonnenreich: All right. Go ahead.

Voir dire examination by Mr. Pollack:

Q. Mr. Rosenthal, which if any of the pins depicted on this photograph is the one carat pin which is in issue in this lawsuit? A. The smallest one.

Q. Can you identify it?

(26)

A. Right here. (Indicating.)

Q. Pointing to the——

Mr. Sonnenreich: Two, on the lefthand side of the photograph.

Q. Two, on the lefthand side of the photograph. In other words the two on the right hand side have nothing to do with this case, is that correct? A. Right.

Mr. Sonnenreich: Mark that.

(Photograph marked Plaintiff's Exhibit No. 1 for identification.)

Examination by Mr. Sonnenreich: (Continued)

Q. Was there a difference in the selling price of Plaintiff's jeweled turtle pins where different gems were employed? A. Yes.

Q. For example, where there were ten rubies, what was the selling price from the beginning to now? A. Approximately 495, until now it may be 245, carat gold weight.

Q. What about where there were diamonds used? A. Diamonds in the beginning about 275 to four and a quarter.

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And what about emeralds?

(27)

A. The same price with emeralds.

Q. What about sapphires? A. Sapphires would be approximately the same price as rubies.

Mr. Sonnenreich: All right. That's it.

Mr. Pollack: I have another question.

Examination by Mr. Pollack:

Q. Do you claim that the two larger turtle pins depicted on the righthand side of the photograph which is Plaintiff's Exhibit 1 are copyrighted? A. Yes.

Q. Do you claim that the defendants' pin which is marked as an exhibit, Defendants' Exhibit B, infringes your copyright of the larger turtle pins? A. I have had no conversation about the larger turtle pin.

Q. Please answer yes or no. A. No.

Mr. Pollack: No further questions at this time.

HERBERT ROSENTHAL

Subscribed and sworn to before
me this 15th day of April, 1974.

MORRIS WINSTON

Deposition of Herbert Rosenthal

(28)

CERTIFICATE

State of New York,
County of New York—ss.:

I, WILLIAM S. DAVIS, a Certified Shorthand Reporter and Notary Public within and for the State of New York, do hereby certify:

That Herbert Rosenthal, the witness whose examination is hereinbefore set forth, was duly sworn by me and that such examination is a true record of the testimony given by such witness.

I further certify that I am not related to any of the parties to this action by blood or marriage, and that I am in no way interested in the outcome of this matter.

IN WITNESS WHEREOF, I have hereunto set my hand this 12th day of March, 1974.

WILLIAM S. DAVIS

**Memorandum and Order of Hon. Charles L. Bricant, Jr.
Dated May 22, 1974**

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

73 Civ. 4865-CLB

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff,

against

**HONORA JEWELRY Co., INC., JERRY J. GROSSBARDT and
STANLEY SCHECHTER,**

Defendants.

BRIEANT, J.

By its complaint filed November 13, 1973, plaintiff, a jewelry manufacturer (hereinafter "Rosenthal"), sues for damages, preliminary and permanent injunctive relief, and an accounting arising out of claimed copyright infringement by defendants (hereinafter collectively "Honora") of its copyright design for a gold, jeweled turtle pin. Plaintiff also seeks destruction of the infringing pins, counsel fees, costs and other relief.

We have subject matter jurisdiction under 28 U.S.C. §1338. All parties are present in this District. Defendants' answer denies copying, and pleads affirmatively that plaintiff failed to comply with the notice requirements (17 U.S.C. §19), never acquired, or alternatively, has abandoned a valid copyright.

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By notice of motion dated April 2, 1974, argued, and fully submitted on April 30, 1974, plaintiff seeks summary judgment in its favor, and a preliminary injunction. Both parties have been deposed.

Plaintiff and defendant Honora each make a turtle pin. A sample of each pin was received at the hearing on this motion. Prior to April 13, 1967, plaintiff had designed for it, by one Lindemann, a jeweled turtle pin made of 14 kt. gold, the back of which was adorned with a cluster of precious gems, including diamonds, rubies, emeralds and sapphires, and combinations thereof. A copyright registration was filed and issued to plaintiff on December 4, 1967. We assume for the purposes of this motion the validity of the copyright, and that plaintiff duly marked its turtle pins, and "has sold [in interstate commerce] hundreds of its turtle pins ranging from \$200 to \$1,000 each, depending upon the gems used" (Affidavit of Herbert Rosenthal, sworn to April 1, 1974).

In 1968, the individual defendants herein, Grossbardt and Schechter, the co-partners doing business under the trade name of Honora Jewelry Co., copied plaintiff's turtle pin exactly. They did so with knowledge. A preliminary injunction against such infringement, granted by Judge Metzner of this Court (68 Civ. 4154) on August 1, 1969, was affirmed on appeal, 428 F. 2d 551, decided June 17, 1970. Thereafter, a final decree enjoining further infringement of the turtle copyright was entered on consent on June 14, 1971. While that litigation was still pending, defendants there, now doing business under corporate form, began making their present turtle, and began to sell it to the public.

Plaintiff here asserts that (Rosenthal Affidavit of April 1, 1974):

"A solid gold figure of a turtle with only slight differences in its body is used by defendants. The

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overall appearance of defendants' pin however, so closely resembles plaintiff's as to give the same impression to any average purchaser. Furthermore, defendant Grossbardt on his deposition admitted using the same stones as plaintiff as well as the same combination of stones. It is apparent to deponent as it should be to this Court that defendants sought to closely simulate plaintiff's pin in order to capitalize on its popularity and the extensive advertising by plaintiff. Defendants further admitted by stipulation dated March 15, 1974 herein, that its selling prices were far below plaintiff's selling prices, leaving your deponent to conclude that defendants used inferior gems and gold in order to undersell plaintiff."

A stipulation of facts dated March 15, 1974, and filed herein, shows, that defendant sold its pins for \$97.50 and \$95.00 since January, 1971, and also sold a smaller pin for prices between \$80.00 and \$102.50. Honora also sold its turtle with different arrangements of stones, such as all diamonds, all emeralds or all sapphires, variously priced, as more particularly set forth in the stipulation.

Plaintiff disclaims any direct evidence of copying. It infers copying solely from a comparison of the two pins, and from defendant's prior conduct in 1968. Defendant has come forward with its evidence, as required by Rule 56, F.R.Civ.P. It showed by documents that on November 30, 1970 it solicited a Hong Kong jewelry designer or manufacturer in writing as follows:

"Regarding the six bug pins and the two different size owl pins we ordered, I would like to know if you can also make an inexpensive turtle pin in two

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sizes, using the same motiff (sic). If you can, please make us the two samples as soon as possible."

In compliance with this letter, the Hong Kong resource on January 5, 1971 invoiced models of the turtle in two sizes. A copy of the invoice is attached to the affidavit of defendant Grossbardt, sworn to April 15, 1974. It was conceded at the hearing of this motion that the turtle which had been knocked off in 1968 was an identical or precise "chinese" copy of plaintiff's pin. This turtle is not.

The parties agree that the test to be applied in determining infringement is "whether an average lay observer would find a substantial similarity in the designs." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 173 F. Supp. 292, *aff'd* 274 F. 2d 487 (2d Cir. 1960). Plaintiff's view of the controversy is best found at page 5 of its brief, where it states:

"[a]lthough different details may certainly be found when the pins are placed side by side, these differences are intended merely to furnish a basis for argument in the courts and have no real impact on the sale of the pin to retail purchasers. To a purchaser of expensive jewelry the designs are the same. The essence of the copyrighted design lies in the arrangement of the gems in an oval shape on the back of a gold turtle. These features are substantially identical in the two designs before the Court. In addition the defendants have utilized the same gems and combination of gems as did plaintiff."

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We do not agree. How else could gems be placed on the back of a gold turtle, other than in an oval shape? That is the natural shape of the shell of any turtle. We do not agree that the essential issue in this case can be decided by visual examination of the two competing turtles.

Plaintiff's reply memorandum (p. 4) concedes, relying on *Soptra Fabrics Corp v. Stafford Knitting Mills, Inc.*, 365 F. Supp. 1199, *rev'd*, 490 F. 2d 1092 (2d Cir. 1974) that "this issue of infringement can be determined by this Court, without the need for a trial, by a mere visible (sic) comparison of the two pins applying the test established in this Circuit."

Plaintiff's President, Herbert Rosenthal, describes his copyrighted pin, as weighing one carat, having ten stones on top averaging ten points apiece, made of nugget gold around the perimeter or fringes, and with four feet and a protruding neck. He testified that defendant's pin, which he claims infringes, was lighter, that it was not made of nugget gold, but a reasonable imitation thereof, that the turtle's tail on Rosenthal's pin was straight, while the tail on the turtle comprising defendant's pin was somewhat curved. Plaintiff's has jewelry stones in the eyes, and the defendant's pin dies not. Plaintiff's pin has flat, or paddle type feet, while defendant's pin indicates toe differentiations. Plaintiff's pin has a gold base holding it together, and defendant's pin has no such base. Plaintiff's pin has a matted finish on the head of the turtle, while defendant's turtle head has a lined finish, but Mr. Rosenthal asserted that this difference in the finish was not observable to the naked eye.¹

¹ In this he is only partly correct. To the naked eye, Ex. A has a higher quality finish to the turtle's head, more pleasing, but not superficially different as to its nature or mode.

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Plaintiff's turtle head comes out straight from the body, while the head on defendant's pin protrudes from the shell of the turtle at an angle from the body. There are twenty-seven little nubs or sections in the shell of plaintiff's, while defendant's has only ten rounded sections with straight lines. The body of plaintiff's pin consists of two pieces, with the top soldered onto the bottom frame, while defendant's appears to have been manufactured in a single piece. Defendant's pin is half the thickness or depth of plaintiff's pin (8 millimeters vs. 4 millimeters). Plaintiff's pin has a line for the mouth of the turtle, and defendant's pin has no mouth on the turtle. These differences or comparisons are all conceded under oath by Mr. Rosenthal at his deposition, taken February 27, 1974, and read in opposition to the motion.

The reptile depicted is not fanciful. He exists in nature. A member of the order Chelonia, he is found in approximately 225 different species, some of which are marine (and properly called turtles). Others inhabit fresh water (terrapin) or are strictly terrestrial (tortoises). Certain distinctive features are possessed by Chelonia in nature. These include the upper carapace or top shell and the lower plastron or bottom shell. Ordinarily at least ten, but not more than twelve, plates are found on the top of the turtle's carapace and fused to the vertebrae, surrounded by a lateral row of eight plates on each side, fused to the ribs, and about twenty-three small plates bordering the edge of the carapace. Neither pin conforms precisely to this structure of carapace, but each has ten stones, precisely equal to the number of vertebral segments found in nature. The plastrons are not disclosed to the observer, and not part of either pin's

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design. A difference exists as to the carapace in that plaintiff's has a higher or deeper dome than does defendant's turtle. The terrestrial branches of the order Chelonia are high-domed, more so than the marine or fresh water reptiles, and their carapace is large enough for the head and limbs to be fully withdrawn. In aquatic species the shell dome is depressed and offers less protection. The digits on the feet are distinct and webbed with respect to fresh water turtles; marine turtles have the digits of their feet all bound together, and often lack claws. Their feet are more nearly similar to paddles. Marine turtles have adapted their feet through evolution, for swimming, rather than walking, which is secondary and limited to sandy beaches. Here a distinct difference appears between defendant's turtle, which is generally a representation of a fresh water turtle, as compared to plaintiff's, whose turtle is more nearly terrestrial in body confirmation, but has marine feet.

Of course, both turtles represent imaginative depictions, and neither one conforms strictly to any species known to nature. Defendant's turtle has well defined separations in the small or outer plates of the carapace, not found on plaintiff's turtle, and a bigger head, further extended. The eyes of defendant's turtle like those of plaintiff's, protrude from the top of the skull.

The differences observed in the turtles by the Court, taken together with the differences conceded by Mr. Herbert Rosenthal on his deposition, compel a finding of no infringement, and also compel the inference of originality, rather than copying.

Plaintiff's view of the case is expressed at his deposition (p. 19, *et seq.*):

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‘Q. Can you tell us in what respects the pin that the defendants made simulated in design the design of your turtle pin? A. To begin with, the general design simulates my design.

Q. In what respect? A. Well, the whole contour, the whole design is similar in my estimation.

Q. Well, surely you do not claim that a turtle is something that is copyrighted to you, that the idea of a turtle, jeweled turtle pin is copyrighted by you, do you? A. Well, that particular one with the ten stones on top is definitely my type of design.

Q. Well, is that what makes it special to you, the ten stones on top? A. To me, to my thinking, it is special to me.

Q. The ten stones? A. Yes.

Q. Is there anything else that makes it special to you? A. And the whole concept of the turtle with ten stones.

Q. In other words, someone could make a turtle without the ten stones and he wouldn't be infringing your copyright, is that correct? A. Right.

Q. Is there any other element of it besides the ten stones which you claim is unique to you? A. Well, that is what I am basing my complaint on.

Q. The ten stones? A. Ten stones and the general idea to simulate my type of turtle.

Q. Well, can you explain or specify what in addition to the ten stones is unique to your pin? A. Merely by turning the head one way and turning the tail another way does not eliminate the general concept of the turtle.

Q. Well, you don't claim that the general concept of the turtle is something that you have a right to copyright, do you? A. I think so.

* * *

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Q. Is there any other respect other than the ten stones in which— A. I have answered the question. I told you, the general concept, the general design. You went into specifics. That is immaterial in my book.

Q. Could you tell me what you mean by the general concept or general design? A. Pardon me. I didn't hear you.

Q. Can you tell me what you mean by the general concept or general design? A. There is a turtle there with a top on it with ten stones and all the arrangements that surround it make up the general concept of the turtle.

Q. Is that what your copyright is all about? A. That's right. You can see that nobody else has made up the turtle.

Q. Would it be your position that any turtle pin that has ten stones in it would infringe your copyright? A. Let me go one step further.

Q. Please answer that question first and then go one step further? A. You don't want extra information? Yes."

The purpose of the copyright laws are to protect original designs from copying, not to convey to the proprietor any right to exclude others from the market place for jeweled turtle pins. Particularly fatuous is plaintiff's claim that the presence of gems in the number of ten, on the back of the turtle is original on its part and protected, or that defendant's turtle also has ten gems is evidence of copying. As we point out, *supra*, p. 8, a turtle has at least ten vertebrae segments on the top of his carapace.

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In this regard each designed was merely representing nature.

Plaintiff cannot appropriate the concept or idea of a jeweled turtle pin, and exclude all others from the jewelry market. American consumers are entitled to preserve their age old right to have the benefit of the fact that there is nothing anyone can design or manufacture which someone else cannot make worse and sell for less.

It is irrelevant to the issues here if defendants are, as charged in the motion papers, bad people, who knocked off plaintiff's copyrighted turtle in 1968. For this misconduct they were duly enjoined by Judge Metzner of this Court, and the preliminary injunction affirmed by our Court of Appeals. This was followed by a consent judgment. Perhaps it was sharp dealing to have signed the consent order, presumably based on some negotiation or discussion with plaintiff, at the same time withholding the fact that the defendant corporation had been formed, and was manufacturing a jeweled turtle pin even while the consent judgment was being discussed. Such disclosure might have prevented this lawsuit, but it is not a factor which we can consider in determining whether or not the turtle pin currently being manufactured by this defendant infringes the plaintiff's copyright. Also, if, as charged, the defendants or some of them submitted a spurious document to Judge Palmieri of this Court in connection with litigation between the same parties concerning the jeweled bee pin (67 Civ. 4674), (Affidavit of Charles Sonnenreich, sworn to April 19, 1974), that contention is as irrelevant as it is disparaging.

The question of whether plaintiff's turtle has been adequately marked with the copyright notice was adjudicated in the prior litigation, and is a matter which, bar-

Memorandum and Order of Hon. Charles L. Brieant, Jr.

ring circumstances arising subsequent to Judge Metzner's order, these parties should be precluded from relitigating by the doctrine of collateral estoppel.

There are no disputed issues of material fact. Plaintiff shows no infringement and has brought forth insufficient evidence in support of this motion to justify a trial of the issue of infringement.

Defendants did not move for summary judgment in their favor, probably because they were dissuaded by the Court's expressions made at a pre-trial conference, at which the plaintiff was urged to accept an immediate trial on the merits in lieu of making this motion. We think adequate authority exists in this Circuit for us to follow the wholesome practice under New York CPLR §3212(b), and in disposing of plaintiff's motion for summary judgment, although not so requested, to grant summary judgment to defendants dismissing the complaint. See *First National Bank in Yonkers v. Maryland Casualty Co.*, 290 F. 2d 246, 251 (2d Cir. 1961), *cert. denied* 368 U.S. 939.

Plaintiff's motions for summary judgment and for a preliminary injunction against further sale of defendant's turtle pin are denied. Summary Judgment is granted to defendants, and the complaint is dismissed.

The Clerk of the Court shall enter judgment pursuant to Rule 58(1), F.R.Civ.P., that all relief shall be denied.

So ORDERED.

Dated: New York, New York
May 22, 1974

CHARLES L. BRIEANT, JR.,
U. S. D. J.

**Judgment Dated June 4, 1974 Dismissing Plaintiff's
Complaint**

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

73 Civil 4865 (CLB)

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff,

against

HONORA JEWELRY CO., INC., JERRY J. GROSSBARDT and
STANLEY SCHECHTER,

Defendants.

Plaintiff having moved the Court for summary judgment and for a preliminary injunction, and the said motion having come on to be heard before the Honorable Charles L. Bricant, United States District Judge, and the Court thereafter on May 23, 1974, having handed down its memorandum and order, denying plaintiff's motion for summary judgment and for a preliminary injunction, and granting summary judgment to the defendants, and directing the Clerk to enter judgment, it is,

ORDERED, ADJUDGED and DECREED: That defendants Honora Jewelry Co., Inc., Jerry J. Grossbardt and Stanley Schechter, have judgment against the plaintiff Herbert Rosenthal Jewelry Corporation, dismissing the complaint.

Dated: New York, N. Y.

June 4, 1974

RAYMOND F. BURGHARDT,
Clerk.

Notice of Appeal

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

73 Civ. 4865

BRIEANT, J.

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff,

vs.

**HONORA JEWELRY Co., INC., JERRY J. GROSSBARDT and
STANLEY SCHECHTER,**

Defendants.

SIR:

Notice is hereby given the Herbert Rosenthal Jewelry Corporation, the above named plaintiff, hereby appeals to the United States Court of Appeals for the Second Circuit, from the order of Hon. Charles L. Brieant, Jr., dated May 23, 1974 denying plaintiff's motion for a preliminary injunction and summary judgment against defendants and the order and judgment filed June 4, 1974 granting summary judgment to the defendants dismissing the complaint herein and the plaintiff appeals from each and every part of said orders and judgment.

**Dated: New York, N. Y.
June 5, 1974**

**CHARLES SONNENREICH,
Attorney for Plaintiff,
500 Fifth Avenue,
New York, N. Y.
354-2910**

Notice of Appeal

To:

POLLACK & SINGER ESQS.
Attorneys for Defendants
61 Broadway
New York, N. Y.

CLERK UNITED STATES DISTRICT COURT
Southern District of New York

**Letter from Charles Sonnenreich to Judge Brieant Dated
June 10, 1974**

(Letterhead of)

CHARLES SONNENREICH
ATTORNEY AT LAW
500 Fifth Avenue
New York, N. Y. 10036

354-2910

June 10, 1974

HON. CHARLES L. BRIEANT, JR.,
United States Courthouse
Foley Square
New York, New York

Re: Rosenthal v. Honora
73 Civil 4865

Dear Judge Brieant:

On page 4 of the Court's Memorandum and Order reference is made to the stipulation dated March 15, 1974 wherein it was stated that the defendant sold its pins

Letter from Charles Sonnenreich to Judge Bricant

since 1971. Further down on the same page the Court incorporates a portion of the letter of the defendant to a Hong Kong firm regarding the manufacture by the latter of "six bug pins" and "an inexpensive turtle pin". On page 5 reference is made to the invoice dated January 5, 1971 from the Hong Kong resource for "models of the turtle in two sizes".

A reading of the Memorandum as presently worded leaves the impression that the turtle pin of the defendants marked Exhibit B, was actually made in its present form and design with the cluster of ten stones, in 1971. This however was not the actual case as clearly appears from the affidavit of the defendant Stanley Schechter sworn to April 24, 1974, subsequent to the stipulation referred to above. Mr. Schechter stated as follows:

- "2. Mr. Rosenthal urges that the only way Honora Jewelry Co., Inc., ("Honora") could have produced a turtle pin set with the stones was to copy the plaintiff's pin. This is nonsense. *Originally Honora produced a fly pin set with a single stone. Thereafter I requested our Hong Kong supplier to make an owl and a turtle to be set with a single stone, such as coral. The owl pin thus set sold well. The turtle pin did not. So Honora took the very same turtle pin, previously set with a single stone, and set it with a cluster of stones instead. If any copying was done it was from Honora's pin and not from any pin made by the plaintiff.*
3. In this connection, Mr. Sonnenreich realleges that the defendants are "attempting to mislead this Court or defraud the Copyright Office".

Letter from Charles Sonnenreich to Judge Brieant

Vulgar abuse is no substitute for honest advocacy. The dates given by the defendants are quite correct. The original turtle pin was supplied by our Hong Kong supplier early in 1971, but *the jeweled turtle pin which the plaintiff complains was not issued prior to March 30, 1972.*" (Emphasis added.)

While the Court's decision rested primarily on its ruling that defendants' pin did not infringe the plaintiff's copyright, the present findings of fact of the Court should conform to the actual facts.

The Court is therefore respectfully requested to file supplemental and corrected findings consistent with the facts.

Respectfully,

CHARLES SONNENREICH,

CS:SS

CC: Pollack & Singer Esqs.
Delivered by hand

**Letter from Pollack & Singer to Judge Bricant Dated
June 10, 1974**

(Letterhead of)

POLLACK & SINGER
61 Broadway
New York, N. Y. 10006

(212) 952-0330

June 10, 1974

By Hand

HON. CHARLES L. BRIANT, JR.,
United States Courthouse
Foley Square
New York, N. Y. 10007

Attention: *Mr. Eisert*

Re: Herbert Rosenthal Jewelry Corporation

v.

Honora Jewelry Co., Inc., et al.

Dear Judge Bricant:

We are in receipt of a letter addressed to your Honor by Mr. Sonnenreich, counsel for Plaintiff, dated June 10, 1974.

We do not believe that there are any errors in your opinion, and we believe that no changes are necessary or appropriate.

Respectfully,

DANIEL A. POLLACK,
Counsel for Defendants

cc: Counsel for Plaintiff

**Memorandum Endorsement of Hon. Charles L. Brieant,
Jr. Dated June 11, 1974**

73 Civ. 4865-CLB

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff,

v.

HONORA JEWELRY CO., INC., JERRY J. GROSSBARDT and
STANLEY SCHECHTER,

Defendants.

ENDORSEMENT

The attached exchange of correspondence is treated as a motion to reargue, and is denied.

The Court relied upon a Stipulation of Facts dated March 15, 1974 and filed herein. Although the Schechter affidavit of April 24, 1974 was in his possession, counsel for plaintiff did not, and to this date has not, applied to this Court to be relieved from the Stipulation of March 15th.

Whether the pin was first produced by defendants in its present form in 1971 or 1972 is in all events a trivial issue, having no effect on the ultimate merits of this litigation.

So Ordered.

Dated: New York, New York
June 11, 1974

CHARLES L. BRIEANT, JR.,
U. S. D. J.

Due and timely service of ^{one (1)} ~~three (3)~~ copies of
the within Joint Affidavit is hereby admitted this
1st day of August, 1974

Mallory & Sings
Attorneys for Defendant - Appellees

